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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,475	03/19/2001	Hideki Yoneda	P20480	8984
7055	7590	11/30/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 11/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,475

Applicant(s)

YONEDA, HIDEKI

Examiner

Dan Kesack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-24 are pending. The rejections are as stated below.

Claim Objections

2. Claims 5 and 17 objected to because of the following informalities: the use of the pronoun "this" in lines 3 and 4 inappropriately identifies an undefined manufacturing capacity. Appropriate correction is required.
3. Claims 7 and 19 objected to because of the following informalities: "the server" in line 1 lacks sufficient specific identifiers for antecedent basis. Examiner suggests changing to "the trading site server" as identified in claim 1, from which claim 7 depends. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3-5, and 14-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-5, and 14-16, the phrase "wherein the configuration to made trades is that", within claims 3-5 and 14-16 renders the claim indefinite, because "configuration to made trades" lacks sufficient antecedent basis, and it is unclear where said configuration is involved in the claimed invention.

Claims 3 and 15, the phrase "most favorable offer" in line 3 renders the claim indefinite for failing to clearly point out the metes and bounds of the claimed invention. "Most favorable" is an objective term, and applicant does not clearly define criteria for making said judgment. Clarification is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 8, 13-17, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. U.S. Patent No. 5,794,204.

Claims 1, 4, 13, and 16, Walker discloses a method and apparatus for a commercial network system designed to facilitate buyer-driven conditional purchase offers. Walker teaches “a purchase access central controller located at a remote server”, a buyer “specifying the subject of the goods he wishes to purchase, a description of the goods he wishes to obtain, and any other conditions the buyer requires” (column 8, lines 45-60). Walker teaches the buyer transmitting this specification to the central controller (column 16, line 64), where it is stored and made available to users. Sellers are able to submit their own offers via bargaining and counter-offer functions of the disclosed invention, in the same manner. Walker teaches a seller logging onto the website and browsing requests for specific goods or services (column 9, lines 10-16). Matches are subsequently made in the system through various methods.

Claims 2-4, and 14-16, Walker discloses multiple methods for matching buyers and sellers in the system. Walker teaches one seller matching one buyer automatically, the parties agreeing on terms, and the transaction being completed. In alternate embodiments, Walker teaches the system choosing a contract “only if no better offer

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has been received” (column 16, lines 41-42). This is analogous to the applicant’s invention where the system chooses the “most favorable offer”. Walker further teaches that a user can browse lists of available contracts by subject, and select one at will (column 9 lines 10-16).

Claims 5 and 17, Walker teaches the user can log onto the website, and see a listing of subject categories, and that the user may have to provide qualifications in order to view a certain subject category, such as verification that the user can provide goods or services in the requested area (column 9, lines 10-22).

Claims 8 and 20, Walker teaches placing conditions related to future events on contracts, such that a user has the right to complete the contract at a predetermined time in the future, for a predetermined price, only if certain conditions exist (column 16, lines 40-45).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 6 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (5,794,204) as applied above, and further in view of Walker et al. 6,108,639.

Walker ('207) fails to teach a penalty posed to the seller of a trade in the case the yield of the product doesn't meet the yield provided in the agreement. Walker ('639) discloses a conditional purchase offer management system, in which a step is taken to ensure that a traded good is authenticated as being exactly as described in the agreed upon conditional purchase offer, wherein a fine can be charged to the seller if agreed upon conditions are not met. It would be obvious to include such a penalty for defaulted contracts into the Walker ('207) invention so as to ensure that trading is honest and secure. The motivation to combine these inventions is further enforced by the common inventorship, and a common parent application of the two references.

11. Claims 7, 9-11, 19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker '204.

Walker '204 fails to teach trading more capacities than the traders really have, trading semiconductor wafer process capacities, semiconductor chip packaging process capacities, or semiconductor testing process capacities, and inputting attribute information in the form of design rules and code information.

Claims 9, 11, 21, and 23, official notice is taken that the system disclosed by Walker ('207) can be used to trade any commodity, product, or service. Trading said capacities would be a possible application of the Walker invention, and is presented as the intended use of the Applicant's claimed invention. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to trade such commodities and services using the invention disclosed in Walker ('207).

Claims 7 and 19, Walker also teaches that agreements between traders can be made for trades to be completed at a predetermined date in the future. Therefore, it is inherent that a trader may trade more service than they can currently accommodate, in anticipation of being able to accommodate said services at the future point in time named in the agreement. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to allow for such agreements to be made, and is presented in the Applicant's claimed invention as the Applicant's intended use.

Claims 10 and 22, Walker ('207) teaches that any specifications pertaining to the request of the user may be entered into the conditional purchase offer. Therefore, the

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attributes specified in claims 10 and 22 represent the Applicant's intended use of the claimed invention, and it would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to include these specific attribute fields in Walker's invention in order to make the resulting embodiment commodity specific.

12. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker ('207) as applied above and further in view of Robinson et al. U.S. Patent No. 5,915,022.

Walker fails to teach recording trouble factors, such as delivery delays, and providing services which result in reduced prices for delivered products.

Walker teaches that in the event of a quality dispute, certain arbitration facilities exist in order to bring about a resolution, in which a buyer may seek damages if the conditional purchase offer is not completed as specified by the buyer, and agreed upon by the seller.

Robinson teaches the use of digital receipts for the sale of goods over the World Wide Web, said digital receipts being used to keep track of delivery dates and potential order problems. Robinson teaches that the merchant may offer substantial discounts for late deliveries (column 6, lines 56-66). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to keep track of such troubles, and to use financial retribution as a means for settling disputes, based on the teachings of Robinson.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**HANI M. KAZIMI
PRIMARY EXAMINER**